

REMARKS

This Request for Continued Examination (RCE) is filed under 37 C.F.R. § 1.114. This RCE is being filed prior to the abandonment of the application, as the Notice of Appeal filed under 37 C.F.R. § 1.191 on July 11, 2005 sets a two-month period for response. The amendments to the claims and the new arguments regarding patentability constitute the submission required for an RCE under 37 C.F.R. § 1.114(c). The fee for a RCE under 37 C.F.R. § 1.17(e) of \$790.00 (large entity) accompanies this RCE.

Claims 1 and 22-50 are currently pending in the above-identified patent application. Claims 22-37 were stated in the prior Office Action to have been withdrawn from consideration. Claims 38-50 are been added by this amendment filed with the Request for Continued Examination. Accordingly, claims 1 and 38-50 remain for consideration; the withdrawal of claims 22-37 from consideration that had been made in the prior Office Action is respectfully traversed.

In the Advisory Action dated July 8, 2005, the Examiner had indicated that the claims amended or added in the Response to Final Office Action mailed on June 3, 2005 would not be entered. Accordingly, entry of these amendments is now respectfully requested.

Claim 1 had previously been rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,242,468 to Barbas et al. ("Barbas et al. '468") in the prior Office Action. This rejection made in the prior Office Action is addressed below.

Reexamination of the application as amended, reconsideration of the rejections and the withdrawal of claims 22-37 from consideration, and allowance of the claims remaining for consideration are respectfully requested in response to this Request for Continued Examination.

I. AMENDMENTS TO THE APPLICATION

Entry of the amendments to the claims is respectfully requested. As detailed below, they introduce no new matter.

These amendments are the same as those made in the Response to Final Office Action mailed on June 3, 2005, but not entered. Accordingly, entry of these amendments in this Request for Continued Examination is respectfully requested

Claim 1 is amended for clarity to recite that the nucleotide-binding activity of the polypeptide resides in the nucleotide-binding region having the sequence of SEQ ID NO:41. This is clear from Figure 1, which recites the nucleotide-binding activity of SEQ ID NO: 41.

New claims 38-50 are equivalent to claims 22-34, but recite a subset of the sequences originally recited in claims 22-34. This follows a suggestion made in the Office Action of March 9, 2005: "It would have been helpful to Applicants and the Examiner if a few consensus sequences had been provided, each representing specific sequences, to ease the search burden."

Accordingly, entry of these amendments is respectfully requested.

II. THE WITHDRAWAL OF CLAIMS 22-37 FROM CONSIDERATION

The Office Action indicated that claims 22-37 have been withdrawn from consideration. Applicant respectfully traverses this decision and respectfully requests that these claims be considered on the merits.

These claims were withdrawn from consideration because they purportedly contained “110 unrelated sequences.” In fact, the sequences are related because of the presence of conservative amino acid substitutions throughout the set of 110 sequences that comprise SEQ ID NOS: 1-110. For example, all of these sequences appear to terminate at their C-terminal end with a basic amino acid, either Lys or Arg. Many have Leu at their fifth amino acid and Val at their sixth amino acid. Thus, it is not proper to consider the subject matter of these claims as directed to “110 unrelated sequences.”

Accordingly, the Examiner is respectfully requested to reverse the withdrawal of these claims from consideration and examine them on the merits.

In addition, claims 34-36 specify one sequence each. The scope of these claims is such that they should be examined, as they do not present an “undue burden” on the Examiner.

Applicant, having presented a novel structure-activity relationship for zinc finger proteins, is entitled to consideration of claims of a reasonable scope reflecting the breadth of the invention. This can be accomplished by reversing the withdrawal of claims 22-37 from prosecution and considering them on the merits.

To clarify the scope of the claims and the sequences recited therein, Applicant has introduced new claims 38-50 essentially equivalent to claims 22-34. These claims should also be examined on the merits.

III. THE REJECTION UNDER 35 U.S.C. § 102(e)

Claim 1 had previously been rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,242,468 to Barbas et al. (“Barbas et al. ‘468”).

This rejection is respectfully traversed.

This rejection is traversed on the grounds that the claim recites an isolated and purified zinc finger-nucleotide binding polypeptide that consists essentially of SEQ ID NO:41. The rejection over Figure 15 of Barbas et al. '468 is over a polypeptide that contains other nucleotide binding regions than SEQ ID NO: 41, so that this rejection does not take into account the effect of the preamble "consists essentially of."

The preamble "consisting essentially of" or equivalent language limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristics of the claimed invention." *In re Herz*, 190 U.S.P.Q. 461, 463 (C.C.P.A. 1976). The comments made in the Advisory Action notwithstanding, "consisting essentially of" is not equivalent to "comprising" and claims using that transitional phrase are properly considered to be partially open rather than open. *In re Garnero*, 162 U.S.P.Q. 221, 223 (C.C.P.A. 1969). The existence of other nucleotide binding regions in the polypeptide of Figure 15 of Barbas et al. '468 does affect the "basic and novel characteristics" of the claimed invention, as the activity of these polypeptides resides in their specific binding of nucleotide sequences.

The use of this transitional phrase, therefore, precludes the possibility of a rejection under 35 U.S.C. § 102(e) over Barbas et al. '468. The rejection over Figure 15 of Barbas et al. '468 is over a polypeptide that contains a framework that affects the ability of the protein to bind the required nucleotide sequences. It is a well-understood principle of protein structure that the secondary and tertiary structure of a protein is directly specified by the primary structure of the protein. The ability of an amino acid sequence to act as a zinc finger motif and bind a specified triplet is therefore highly dependent on the secondary and tertiary structure of the protein. The zinc finger proteins of Barbas et al. '468, including that of Figure 15, are provided by minimal modification of the wild-type zinc finger proteins Zif268.

In contrast, the zinc finger polypeptides of the present invention are derived by modular assembly and are not directly related to Zif268 in their primary sequence. This means that the secondary and tertiary structures of the proteins differ significantly.

The application of this principle of protein chemistry meets the burden of showing that the introduction of additional components would materially change the characteristics of applicant's invention. In re De Lajarte, 143 U.S.P.Q. 256 (C.C.P.A. 1964).

Therefore, the Examiner is respectfully requested to withdraw this rejection.

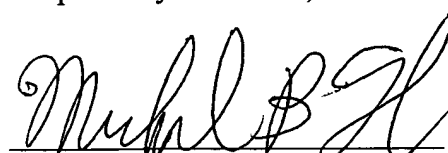
IV. CONCLUSION

In conclusion, claims 22-37 should be examined on the merits together with new claims 38-50.

All claims for consideration are patentable over the prior art of record, whether considered individually or in combination. Accordingly, prompt allowance of these claims is respectfully requested.

If any issues remain, the Examiner is respectfully requested to telephone the undersigned at (858) 200-0581.

Respectfully submitted,


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